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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,834	02/13/2002	Edward Raynes Eaton	TH1871Y	6354
23632	7590	02/07/2006	EXAMINER	
SHELL OIL COMPANY P O BOX 2463 HOUSTON, TX 772522463			OGDEN JR, NECHOLUS	
			ART UNIT	PAPER NUMBER
			1751	
DATE MAILED: 02/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,834

Applicant(s)

EATON ET AL.

Examiner

Necholus Ogden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-21-2005 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fitzpatrick et al (4,617,490).

Fitzpatrick et al disclose a cathode ray tube device with improved color filtering system comprising 20 to 80% by weight of an alcohol such as 1,3 propanediol that not only act as a filtering medium but is an excellent coolant for the tube during operation while rendering the tube resistant to freezing during storage (col. 2, lines 20-37).

As this reference appears to teach all of the instantly required it is considered anticipatory.

In the alternative, Fitzpatrick et al is silent with respect to the electrical resistivity, boiling point, thermal conductivity, viscosity, heat capacity, and rejecting surface capacity. However, it would nonetheless been inherent to the compositions of Fitzpatrick to encompass the above mentioned characteristics because the

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compositions of Fitzpatrick et al specifically teach with sufficient specificity the specific 1,3 propanediol (trimethylene glycol) for the use as solution that has coolant and antifreeze properties. Therefore, the skilled artisan would have expected similar characteristics of the solutions disclosed in Fitzpatrick et al, in the absence of showing to the contrary.

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harman et al (2,725,359).

Harman et al disclose a lubricating oil composition suitable for use as a coolant and/or corrosion inhibiting composition (col. 1, lines 15-19) comprising an additive such as trimethylene glycol in an amount from 0.01 to 20% by weight (col. 7, lines 30-33 and col. 8, lines 33-35).

As this reference appears to teach all of the instantly required it is considered anticipatory.

In the alternative, Harman et al is silent with respect to the electrical resistivity, boiling point, thermal conductivity, viscosity, heat capacity, and rejecting surface capacity. However, it would nonetheless been inherent to the compositions of Harman et al to encompass the above mentioned characteristics because the compositions of Harman et al specifically teach with sufficient specificity the specific 1,3 propanediol (trimethylene glycol) for the use as and additive in coolant compositions with anticorrosive properties. Therefore, the skilled artisan would have expected similar characteristics of the compositions disclosed in Harman et al , in the absence of showing to the contrary.

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When the species is clearly named, the species claim is anticipated no matter how many other species are additionally named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) See also In re Sivaramakrishnan, 673 F.2d 1383, 213USPQ 441 (CCPA 1982).

8. Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nambu (4,925,603).

Nambu discloses a gel cooling medium comprising an aqueous solution of polyvinyl alcohol and a water soluble organic compound or freezing point depressing agent such as 1,3 propylene glycol or 1,3 propanediol in an amount from 20 to 80% by weight (col. 9, lines 40-68 and col. 10, lines 15-16).

As this reference teaches all of the instantly required it is considered anticipatory.

In the alternative, Nambu is silent with respect to the electrical resistivity, boiling point, thermal conductivity, viscosity, heat capacity, and rejecting surface capacity. However, it would nonetheless been inherent to the compositions of Nambu to encompass the above-mentioned characteristics because the compositions of Nambu specifically teach with sufficient specificity the specific 1,3 propanediol (trimethylene glycol) for the use as and additive in coolant compositions. Therefore, the skilled Nambu, in the absence of showing to the contrary.

Response to Arguments

9. Applicant's arguments filed 11-12-2005 have been fully considered but they are not persuasive.

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Applicant argues that Fitzpatrick et al do would not encompass the heat rejecting surface capacity as claimed because of additional components such as cinnamaldehyde or cinnamyl alcohol that are disclosed therein.

The examiner contends that the heat rejecting surface capacity would be inherent to the 1,3 propanediol as suggested by applicant's specification and examples that only require 1,3 propanediol and water in their compositions. As Fitzpatrick et al teach 1,3 propanediol it would inherently meet that limitation. With respect to the additional components, required by Fitzpatrick et al, the examiner contends that applicants claimed composition is open to include additional components not required by the claims.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1 and 3-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,818,146. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in subject matter pertaining to coolant compositions with a 1,3 propanediol compound.

12. Claims 1 and 3-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/886,298. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in subject matter pertaining to coolant compositions with a 1,3 propanediol compound.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholas Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nicholas Ogden
Primary Examiner
Art Unit 1751

No
1-31-2006